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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,542	02/10/2004	Christopher Powell DeBolt	554-1-002	3119

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EXAMINER
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HYUN, PAUL SANG HWA

ART UNIT	PAPER NUMBER
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1797

MAIL DATE	DELIVERY MODE
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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/776,542	<b>Applicant(s)</b> DEBOLT, CHRISTOPHER POWELL	
	<b>Examiner</b> PAUL S. HYUN	<b>Art Unit</b> 1797	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 February 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/10/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Objections***

Claims 6, 7, 9, 10, 14, 15, 19 and 20 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claims 6, 7, 19 and 20, only limit the structure of the microscope base, which is not part of the claimed invention. Therefore, the claims do not further limit the claimed invention.

Likewise, claims 9, 10, 14 and 15 further limit the structure of the microscope plate, which is not an element of the claimed invention.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims **1-3, 6, 7, 9-16, 19 and 20** are rejected under 35 U.S.C. 103(a) as being unpatentable over DeBolt.

The DeBolt reference submitted by Applicant in the IDS shows a microplate indexing device bearing the name Speedview®. Speedview® comprises a base platform designed to be attached to the stage of a microscope, and an indexing platform adapted to receive a microplate thereon. Each platform comprises a view-through portion aligned with one another to enable viewing of the samples in the wells of the microplate by using a microscope. The indexing platform further comprises a pair of parallel rails that enable the microplate to slide in a single axis, and a column of indexing holes formed in grooves on each side of the view-through portion (one column functioning as the claimed indexing holes and the other column functioning as the claimed guide groove) that interacts with a pair of indexing pins (one functioning as the claimed indexing pin and the other functioning as the claimed guide pin) provided on the base platform to enable the indexing platform to move in a sequential manner in a direction that is transverse to the direction enabled by the rails. The indexing platform also comprises a plurality of labels, each label associated with an indexing hole.

Speedview® differs from the claimed invention in that the indexing pins and the indexing holes of the Speedview® are situated on the base platform and the indexing platform, respectively, instead of the indexing platform and the base platform, respectively. However, it would have been obvious to one of ordinary

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skill in the art to switch the locations of the indexing pin and the indexing holes such that the indexing pin is provided on the indexing platform and the indexing holes are provided in the base platform. See *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950) (holding that claims to a hydraulic power press which read on the prior art except with regard to the position of the starting switch were held unpatentable because shifting the position of the starting switch would not have modified the operation of the device).

With respect to claims 6, 7, 19 and 20, it should be noted that the claims further limit the structure of the microscope base, which is not part of the claimed invention. Therefore, limitations directed toward the microscope base are non-limiting.

Likewise, claims 9, 10, 14 and 15 further limit the structure of the microscope plate, which is not an element of the claimed invention.

Claims **4, 5, 17 and 18** are rejected under 35 U.S.C. 103(a) as being unpatentable over DeBolt in view of Casteel et al. (US 2001/0043004 A1).

Although Speedview® is configured to be secured to the stage of a microscope, the DeBolt reference does not explicitly disclose slip-resistant feet for securing the Speedview® to the stage of a microscope.

Casteel et al. disclose a piece of furniture comprising a textured bottom surface made from polyurethane (see [0041]). The reference discloses that the polyurethane surface reduces slippage. In light of the disclosure of Casteel et al.,

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it would have been obvious to one of ordinary skill in the art to secure the Speedview® to the microscope stage using polyurethane slip-resistant feet.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over DeBolt in view of Ozeki (US 4,836,667).

Although Speedview® is configured to be secured to the stage of a microscope, the DeBolt reference does not explicitly disclose pins for securing the Speedview® to the stage of a microscope.

Ozeki discloses a microscope stage configured to receive a sample substrate thereon wherein the stage comprises pins 77 located at the corners for securing the sample substrate thereto, and the sample substrate comprises corresponding holes for receiving the pins (see claim 6 and Fig. 1B). In light of the disclosure of Ozeki, it would have been obvious to one of ordinary skill in the art to provide the base platform of the Speedview® with holes for receiving pins protruding from the stage of a microscope.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL S. HYUN whose telephone number is (571)272-8559. The examiner can normally be reached on Monday-Friday 8AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267. The fax

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phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Yelena G. Gakh/  
Primary Examiner, Art Unit 1797

/Paul S Hyun/  
Examiner, Art Unit 1797